



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,690	03/17/2004	Dov Pikielny	1416DOV-US	1888

32964 7590 11/08/2005

DEKEL PATENT LTD., DAVID KLEIN  
BEIT HAROF'IM  
18 MENUHA VENAHALA STREET, ROOM 27  
REHOVOT, 76209  
ISRAEL

EXAMINER

JOHNSON, STEPHEN

ART UNIT PAPER NUMBER

3641

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/801,690

Applicant(s)

PIKIELNY, DOV

Examiner

Stephen M. Johnson

Art Unit

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-17 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,5-11,20 and 21 is/are allowed.
- 6) ☒ Claim(s) 2,4,12-17,22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/30/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

1. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, line 2, the phrase “a floor plate” should be claimed as [said floor plate] if the previously claimed floor plate is intended.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, **the magazine well and weapon** (see claim 2) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 3641

3. The proposed replacement sheet directed to fig. 3 is disapproved. (1) Since the sheet that includes fig. 3 does not replace a previous sheet, it should be classified as a “New Sheet” rather than a replacement sheet. (2) The submitted new fig. 3 is of more detail with regard to both the firearm structure as well as the pivotally attached arm 60 and the pinned joint or bearing 62 than is supported by the application as originally filed. Although, there is reference to these structures in the written specification as originally filed, it is not of enough detail to support what is included in newly submitted fig. 3. (3) The replacement sheet directed to figs. 1 and 2 has been approved.

4. The disclosure is objected to because of the following informalities: The amendments to the page 3, third paragraph, and page 4, first paragraph are inappropriate because they reference fig. 3 which has been denied entry.

**Appropriate correction is required.**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 12-13 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by

Herold et al..

Herold et al. disclose a weapons magazine comprising:

- |  |    |
|--|----|
| a) a magazine body ;                           | 10 |
| b) a biasing device ;                          | 26 |
| c) a power source;                             | 46 |
| d) a light (LED) mounted on the magazine body; | 30 |

- |                                 |                |
|---------------------------------|----------------|
| e) a floor plate;               | 16 (bottom of) |
| f) a switch; and                | 48             |
| g) a weapon with magazine well. | 12, 14, 19     |

7. Applicant's arguments are addressed as follows. While it is the case that the term "retrofit kit" is now given patentable weight because of its inclusion in the preamble of the claim and later reference in the body of the claim, it is still anticipated by Herold et al. in view of the fact that the "retrofit kit" as defined in claim 12 includes only elements that are included in the confines of Herold et al..

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herold et al. in view of Kaminski.

Herold et al. apply as previously recited. However, undisclosed is a laser switch that is a transceiver. Kaminski teaches a laser switch that is a transceiver 62. Applicant is substituting one laser switch for another in an analogous art setting as explicitly encouraged by the secondary reference (see Kaminski (fig. 4)). It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Kaminski to the Herold et al. weapons magazine and have a weapons magazine with a different type of laser switching means.

10. Claims 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Fell et al..

Fell et al. disclose a weapons magazine comprising:

a) a magazine body ;	see figs. 4, 5
b) a biasing device ;	7
c) a power source;	22
d) a light mounted on the magazine body;	15, 16
e) a floor plate;	45
f) a switch; and	5
g) a weapon with magazine well.	see fig. 1

11. Applicant's arguments are addressed as follows. While it is the case that the term "retrofit kit" is now given patentable weight because of its inclusion in the preamble of the claim and later reference in the body of the claim, it is still anticipated by Fell et al. in view of the fact that the "retrofit kit" as defined in claim 12 includes only elements that are included in the confines of Fell et al..

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fell et al. in view of Holcomb et al..

Fell et al. apply as previously recited. However, undisclosed is an RF transceiver attached to the bottom of the magazine to emit signals. Holcomb et al. teach an RF transceiver attached to the bottom of the magazine to emit signals (col. 6, lines 53-59). Applicant is selecting a means known in this art to transmit signals to identify the location of a firearm in use and putting it to use as it is already commonly known to be used in this art. It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Holcomb et al. to the Fell et al. magazine and have a magazine with an RF transceiver.

Art Unit: 3641

13. Claims 12-13 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Willoughby et al..

Willoughby et al. disclose a weapons magazine comprising:

- a) a magazine body ; 56, 58
- b) a biasing device ; inside 56
- c) a power source; 74
- d) a light mounted on the magazine body (laser diode); 72
- e) a floor plate; see fig. 3
- f) a switch; and 76
- g) a weapon with magazine well. see fig. 2

14. Applicant's arguments are addressed as follows. While it is the case that the term "retrofit kit" is now given patentable weight because of its inclusion in the preamble of the claim and later reference in the body of the claim, it is still anticipated by Willoughby et al. in view of the fact that the "retrofit kit" as defined in claim 12 includes only elements that are included in the confines of Willoughby et al..

15. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crain (138) in view of Sayre (730).

Crain (138) discloses a weapons magazine comprising:

- a) a magazine body; 58
- b) a biasing device; 60
- c) a power source disposed in the magazine body; 72
- d) a switch; and 76

Art Unit: 3641

e) a light mounted on a surface of the magazine body. 40, 42

Crain (730) applies as recited above. However, undisclosed is a light mounted on a surface of the magazine body that points in a direction other than towards or opposite the shooting direction of the weapons. Sayre (730) teaches a light mounted on a surface of the magazine body that points in a direction other than towards or opposite the shooting direction of the weapon (8, 24). Applicant is substituting one orientation for an output display for another in an analogous art setting. It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Sayre (730) to the Crain (730) weapons magazine and have a weapons magazine with an output display oriented toward the side as taught by Sayre (730).

16. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crain (138) in view of Sayre (730) as applied to claim 2 above, and further in view of Toole et al. (600).

Crain (138) and Sayre (730) apply as previously recited. However, undisclosed is a means for flexibly and pivotally mounting a firearm light to the firearm frame. Toole et al. (600) teach a means for flexibly and pivotally mounting a firearm light to the firearm frame (see figs. 3, 4). Applicant is selecting and assembling a means for attaching a light to a firearm and putting it to use as it is already commonly known to be used in this art. It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Toole et al. (600) to the magazine of Crain (138) in view of Sayre (730) and have a magazine with a pivotally and flexibly attached firearm light.

17. Claims 1, 5-11, and 20-21 are allowed.



18. Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

19. Applicant's arguments filed on 8/30/2005 have been fully considered but they are not persuasive. These arguments have been addressed in the preceding paragraphs of this Office action.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

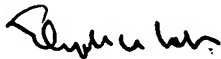
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Johnson whose telephone number is 571-272-6877 and whose e-mail address is ([Stephen.Johnson@uspto.gov](mailto:Stephen.Johnson@uspto.gov)). The examiner can normally be reached on Tuesday through Friday.

Art Unit: 3641

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The Central FAX phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 800-786-9199.



**STEPHEN M. JOHNSON**  
**PRIMARY EXAMINER**

Stephen M. Johnson  
Primary Examiner  
Art Unit 3641

SMJ  
November 3, 2005